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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,883	01/10/2000	SCOTT T. ALLAN	A-65188-1/TO	4877

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EXAMINER

JASMIN, LYNDIA C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/480,883

Applicant(s)

ALLAN ET AL.

Examiner

Lynda C Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9-11,13,14,21-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9-11,13,14,21-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Preliminary Amendment received on June 19, 2000 has been acknowledged.

Oath/Declaration

2. The oath or declaration is defective because: Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Information Disclosure Statement

3. The Copending Applications in the information disclosure statement (IDS) submitted on April 06, 2001 have been considered. However, they have been crossed out since they are US Applications and will not be listed as references cited should the present application be issued as a patent.

Specification

4. The abstract of the disclosure is objected to because the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities:
on page 2 of the preliminary amendment under the Related Applications the applicants are requested to provide the US application serial numbers matching the Attorney Docket No.

on page 9, the table of contents should be deleted to avoid confusion if pages were to be changed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 22-26, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 22-26 the recitation "comprising the step of then using" and/or "the step of using comprises then using" renders the claims indefinite. The language is confusing and not positively set forth. Same as in claims 30 and 31. Clarification is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being

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examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1, 4, 10, 11, 22, 23, 27 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. (5,915,022).

Robinson et al. discloses a method for storing and retrieving electronic records as claimed with the step of: creating a transaction at a merchant (a virtual merchant via the merchant's site) by buying one of goods and service (transaction is created after confirmation) (col. 4, lines 4-8), authorizing the transaction with an electronic signature (col. 8, lines 6-8), forwarding an electronic record of the transaction, including the electronic signature and a text description of a line item (information regarding the transaction), to an electronic-record repository (col. 5, lines 6-11) (col. 5, lines 59-64). The transaction is created by buying from a virtual merchant (via World Wide Web transaction).

Robinson et al. further discloses the step of generating a receipt for the transaction from the electronic record forwarded to the electronic-record repository (via a digital receipt page), and retrieving a copy of the electronic record (at step 146) from the electronic-record repository over an Internet (using a Public Network). The electronic record is viewed (to compare information previously stored) including the electronic signature (col. 8, lines 55-57). The retrieved electronic record is used as proof of the transaction (col. 7, lines 37-39). The electronic record (digital receipt) is

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used as proof of the transaction in order to dispute an alternative record of the transaction (col. 6, lines 51-53).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (5,915,022).

Robinson et al. discloses the process steps of storing and retrieving the electronic record in case of disputes or problems with the order, with the exception of using the electronic record as proof of the transaction in order to return/exchange the bought goods or service, or to file a warranty claim with respect to the bought goods or service. This practice is well known in the business community and would follow in the Internet world as well where customer is worldwide. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the well known steps of providing the electronic record as proof of transaction in order to return/exchange and to file a warranty claim of the bought goods or service in the process of Robinson et al. for the purpose of streamlining the process and saving time spent by customer searching for paper transaction.

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12. Claims 3, 9, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (5,915,022), in view of Ballard (5,910,988).

Robinson et al. discloses the process steps of the claimed invention, with the exception of forwarding to the electronic-record repository an electronic record of a transaction created at a business other than the merchant, generating a paper receipt for the transaction; and retrieving a replica of the paper transaction receipt from the electronic-record repository over an Internet.

Ballard discloses the concept of having a remote data acquisition, data archival and data retrieval system (DataTreasuryTM System, hereafter "DAT") with the steps of forwarding to an electronic-record repository (DAT) an electronic record of a transaction created at a business other than a merchant (col. 3, lines 52-57), generating a paper receipt for the transaction (as illustrated in Fig 3B), and retrieving a replica of the (scanned) paper transaction receipt from the electronic-record repository over an Internet (col. 3, 58-60).

From this teaching of Ballard, it would have been obvious to one of ordinary in the art at the time the invention was made to modify the merchant database of Robinson et al to include the centralized processing and storage taught by Ballard in order to facilitate a wider range of processing documents and electronic data from different applications including sale, business, banking and general consumer transaction.

13. Claims 13, 14, 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (5,915,022), in view of Kobayashi et al. (5,864,825).

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Robinson et al. discloses the process steps of the claimed invention, with the exception of offering a search of an electronic-record repository by text line-item description and printing a copy of the electronic record from the electronic-record repository.

Kobayashi et al. discloses the process steps of offering a search of an electronic-record repository by text line-item description (data of goods such as name of articles) (col. 4, lines 63-67), and retrieving requesting receipt from a host unit and transferred the data result to a printer, which prints the results (at S17).

From this teaching of Kobayashi et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retrieving process of Robinson et al to include the searching and printing of the receipt from a storage as taught by Kobayashi et al. in order to provide a transcript of a purchase receipt when the receipt is missing.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yoshida discloses a transaction inquiring which retrieve and display transaction information.

Smorodinsky discloses a system where payment message is stored in a database of a billing presentment computer and in a closing record of an electronic

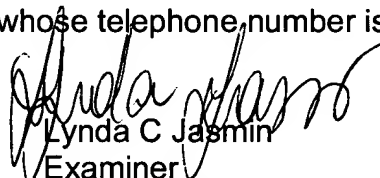
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payment subsystem. The stored payment message can be used to resolve certain disputes, which may arise between a biller and a customer.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.


Lynda C Jasmin
Examiner
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lj
August 19, 2002